Remarks/Arguments

In the official action mailed May 16, 2008, the examiner maintained the rejection claims 1-9 under 35 U.S.C. § 103(a) over U.S. Patent No. 6,593,468 to Lange et al. ("Lange") in view of U.S. Patent No. 3,418,133 to Nijhoff et al. ("Nijhoff") and U.S. Patent No. 3,928,252 to Rigler et al. ("Rigler").

In response to the rejection, applicants provide the following distinguishing commentary, which is believed to place the present case in condition for allowance. Favorable reconsideration of all of the pending claims is respectfully requested.

I. The Rejection of Claims 1-9 under 35 U.S.C. § 103(a) over Lange in view of Nijhoff and Rigler

As previously argued, use of the state of the art CMCs in fruit has certain disadvantages such as insufficient gelling properties, low solubility, along with the requirement that they be used in high amounts. Consequently, in practice, the industry uses **pectin** instead of CMC in fruit-based products, which is disadvantaged in its own right in that there is limited possibility of using other solids in the fruit-based product.

Use of the **specific CMC** in accordance with the present invention in fruit-based products unexpectedly leads *inter alia* to an improvement in gelling properties, flowing properties, consistency, and stability. Additionally, use of these gel forming CMCs effectively prevents fluid loss or syneresis and these CMCs are soluble in both hot and cold water.

The primary reference to Lange, which is an U.S. equivalent of WO 99/20657 discussed in the application (last lines of p. 3), discloses CMCs similar to those utilized in the present claims in that they are characterized in having a G' that is greater than G" over the frequency range of 0.1-100 Hz when measured as indicated in claim 1, which basically means that these CMCs are "capable" of forming gels. Lange does not,

however, disclose or suggest the use of the disclosed specific CMCs in fruit-based products.

In order to alleviate the deficiencies of Lange, the examiner relies on the secondary references. As previously argued, the Nijhoff and Rigler patents disclose **state of the art** or conventionally known CMCs and their use in fruit-based products. It is undisputed that the secondary references **do not disclose** the specific CMC's utilized in Lange and/or the present claims. Further, the secondary references cannot reasonably be viewed as suggesting that **ALL CMC's would work in fruit based products**, because it is clear that some will not work. Since, neither secondary reference discloses using the specific CMC's of Lange in fruit based products, and since it is factual that not all CMC's do, in fact, work and/or are useable in fruit based products, applicants submit that the present rejection is improper.

In determining whether a person of ordinary skill would have been led to the combination of references employed by the examiner, it is improper to simply to use that which the inventor taught against its teacher. In other words, there must be a **reason or suggestion** in the art for making the combination, other than the knowledge learned from the applicant's disclosure. The suggestion to combine references must not be derived by hindsight from knowledge of the invention itself.

Beyond looking to the prior art to determine if it suggests doing what the inventor has done, one must also consider if the art provides the required expectation of succeeding in that endeavor. Both the suggestion and the expectation of success must be founded in the prior art, not in applicant's disclosure. Obviousness does not require *absolute* predictability, but a reasonable expectation of success is necessary.

In the present situation, while cited art may have rendered it obvious to use **conventional** CMC's in fruit based products, absent prohibited hindsight reliance on applicants' disclosure, there is absolutely no suggestion to use the **specific** CMC's of

the claimed invention (and/or of Lange) in fruit based products. Further, the cited art provides no grounds supporting that there would be a reasonable expectation of success in using the **specific** CMC's of Lange in fruit based products. More specifically, Lange clearly does not disclose or suggest the use of gel-forming CMCs in fruit-based products. Further, one of ordinary skill in the art, knowing the problems with use of the state of the art CMCs in fruit - based products, would therefore not consult Lange with a reasonable expectation of solving the above problems, as Lange does not deal with alleviating such problems in fruit based products.

In this regard, the assignee for the present application manufactures many specialty CMC's grades, some are food grade, and some are not. For example, some speciality and/or modified CMC's are used in **drilling muds** (oilfield applications), as **iron ore pelletizing/agglomerating agents** and the like**. Is it really the examiner's position that the secondary references make it obvious to use any specialty CMC, including these non-food grade specialized CMC's, in fruit based products?** Applicant's think not and respectfully submit that at best, the secondary references may have made it "obvious to try" such CMC's, including the CMC's of Lange, in fruit based products, but obvious to try is clearly not a legitimate standard of patentability.

Regarding obvious to try, the examiner is respectfully directed to *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988). "In some cases, what would have been 'obvious to try' would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful. In others, what was 'obvious to try' was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it." *Id.* at 903, 7 U.S.P.Q.2d at 1681 (citations omitted).

In re O'Farrell is factually on point with the present case. In the present situation, the secondary references may have made it 'obvious to try' other CMC's, and to vary all parameters (such as (DS) and (DP)) or try each of numerous possible choices until one possibly arrived at a successful result. However, the cited art gives no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful. Without such information, applicants submit that the present rejection is not supported and must fail.

In view of the foregoing, applicants respectfully submit that the present rejection is improper; reconsideration and withdrawal thereof is respectfully requested.

Therefore, the present case is believed to be in condition for allowance, which action is respectfully requested.

Respectfully submitted,

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